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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200153
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 85/069,828
Mark: MANGO’S TROPICAL CAFE & Design

UNIVERSAL INTERNATIONAL MUSIC B.V.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91200153
)	
MANGO’S TROPICAL CAFE, INC.)	
)	
Applicant.)	
)	

OPPOSER’S MOTION PURSUANT TO FEDERAL RULE 56(d)

Early in the discovery period, Applicant Mango’s Tropical Cafe, Inc. (“Applicant”) has filed a motion for summary judgment (“Applicant’s Motion” or “Motion”) involving highly factual issues that require development through discovery. Given both the timing of Applicant’s Motion and the fact that this motion will only delay instead of expedite these proceedings, Opposer Universal International Music B.V. (“Opposer”), pursuant to Federal Rule of Civil Procedure (“Rule”) 56(d)(1), hereby moves the Board for an Order denying Applicant’s Motion outright. In the alternative, Opposer seeks an opportunity to conduct reasonable discovery pursuant to Rule 56(d)(2) to enable it to respond to Applicant’s Motion. In support thereof, Opposer submits the attached Declaration of Brent S. LaBarge (“LaBarge Decl.”) outlining the grounds on which Opposer contends it cannot effectively oppose Applicant’s Motion without an opportunity for discovery.

INTRODUCTION

As grounds for opposition, Opposer has alleged that Applicant’s MANGO’S TROPICAL CAFE & Design mark (Applicant’s Mark) is likely to be confused with Opposer’s prior rights in

its registered and common law MANGO marks (“Opposer’s MANGO Marks”) when used in connection with the “DVDs featuring music and live entertainment” included in Applicant’s Application Serial No. 85/069,828 (the “Contested Application”). On November 4, 2011, Applicant filed a motion for summary judgment asserting that no likelihood of confusion exists between the parties’ marks as a matter of law, necessitating Opposer’s Rule 56(d) Motion. Although Opposer served discovery requests before Applicant filed its Motion, this proceeding was suspended before Applicant’s responses were due. Thus, to date, neither party has had the benefit of any fact discovery whatsoever.

In its Motion, Applicant relies heavily on the alleged dissimilarities between the parties’ respective marks, ignoring the fact that Opposer’s ownership of a registration for MANGO in standard characters (Reg. No. 1,200,278) entitles it to rights in MANGO in the same font, in the same colors, and paired with the same design as used by Applicant in connection with its mark. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1353 (Fed. Cir. 2011) (A registrant is entitled to all depictions of a standard character mark “regardless of font style, size, or color, not merely ‘reasonable manners’ of depicting” such mark). Further, Applicant ingenuously emphasizes the highly descriptive “tropical cafe” wording in its mark, notwithstanding the fact that Applicant disclaims this phrase in the majority of its active applications and registrations. Applicant also frequently uses its mark in a manner that makes “tropical cafe” all but impossible to see, and consumers and Applicant alike refer to Applicant simply as “Mango’s.”

Further belying Applicant’s claims are Applicant’s own efforts to cancel or oppose registration of marks far more dissimilar to Applicant’s Mark than Opposer’s MANGO marks. Tellingly, one of Opposer’s MANGO Marks was also cited against Applicant’s application to

register its mark for use in connection with music CDs, Serial No. 76/157,782 (the “CD Application”).¹ More recently, a different examining attorney cited Opposer’s pleaded marks *and* Applicant’s Contested Application and CD Application against a third party’s efforts to register MANGO MOBILE TV, Serial No. 85/375,340.

Even against this cursory background it becomes quickly apparent that this case cannot be resolved as a matter of law against Opposer without the benefit of any discovery whatsoever. Opposer therefore respectfully request that the Board either deny Applicant’s Motion outright or, in the alternative, grant Opposer the opportunity to conduct discovery necessary to present facts essential to support its opposition to Applicant’s Motion.

STATEMENT OF FACTS

On June 6, 2011, Opposer initiated Opposition No. 91200153 against the Contested Application on the grounds of likelihood of confusion with Opposer’s MANGO Marks for legally identical goods. LaBarge Decl. ¶ 3.

The parties held the required discovery conference on September 19, 2011, resulting in a moratorium on discovery through October 15, 2011 to permit the parties sufficient time to seek an amicable resolution of this matter. Opposer communicated a settlement proposal to Applicant on October 10, 2011. On October 18, 2011, the parties exchanged Initial Disclosures via email. During this exchange, Opposer expressed that it was looking forward to receiving Applicant’s response to the outstanding settlement proposal. Notwithstanding the end of the discovery moratorium, Opposer refrained from serving discovery requests to give Applicant ample

¹ Opposer plans to file a petition to cancel any registration resulting from the CD Application. Opposer also notes that Applicant’s CD Application has a rather convoluted history. The currently-pending CD Application appears to be a divisional of a divisional application, resulting in several different serial numbers referenced throughout the prosecution file for this application.

opportunity to consider Opposer's proposal. At the time, Opposer believed that a good-faith counterproposal from Applicant would be forthcoming. *Id.* ¶¶ 4-7.

On November 1, 2011, Opposer received an email from Applicant giving Opposer less than 48 hours in which to agree to withdraw its opposition, with prejudice. Absent compliance with these demands, Applicant stated that it was going to proceed with a motion for summary judgment. *Id.* ¶ 8.

Once it became apparent that Applicant was no longer interested in settlement discussions, Opposer elected to move forward with discovery, serving first sets of interrogatories, document requests, and requests for admission on November 3, 2011. Applicant filed its Motion on November 4. On November 8, 2011, the Board suspended the above proceedings (including outstanding discovery) pending disposition of Applicant's Motion. As a result, Opposer has not had any opportunity to conduct the fact discovery needed to respond to the allegations in the Motion. *Id.* ¶¶ 9-11.

On **December 8, 2011**—a day before Opposer's response deadline and over a month after Applicant filed its Motion—Opposer received the service copy of the Motion. *Id.* ¶ 12.

ARGUMENT

Where, as here, the nonmovant has not had an opportunity to discover information that is essential to its opposition, Rule 56(d)² permits the Board to refuse summary judgment outright. *See, e.g., Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 n.5 (1986) (Rule 56[(d)] safeguard permits "summary judgment [to] be *refused* where the nonmoving party has not had the opportunity to discover" essential information) (emphasis added). Alternatively, Rule 56(d) allows the Board to order a continuance to permit necessary discovery. *See generally* TBMP

² Former Rule 56(f) was recently amended and renumbered as Rule 56(d). This renumbering carries forward without substantial change the provisions of former subdivision (f). Accordingly, former Rule 56(f) and current Rule 56(d) are referred to simply as Rule 56(d) throughout this motion.

§ 528.06; Rule 56(d)(2); *see also Opryland USA Inc. v. The Great Am. Music Show, Inc.*, 970 F.2d 847, 852 (Fed. Cir. 1992) (“[W]hen the discovery is reasonably directed to facts essential to justify the party’s opposition . . . [1] such discovery must be permitted or [2] summary judgment refused.”) (internal citations and quotation marks omitted). As discussed more fully below, Applicant’s Motion should be denied outright, or, in the alternative, Opposer should be granted leave to conduct the discovery requested herein.

I. Applicant’s Motion for Summary Judgment Should Be Denied.

As Applicant acknowledges, “[t]he purpose of summary judgment is one of judicial economy.” Appl.’s Br. at 2. Applicant’s Motion, however, accomplishes just the opposite: to delay the proceedings at a time when both Applicant and Opposer could be fully developing the record necessary to address the claims that have been—or will be—asserted in this dispute. Even without discovery, numerous material disputed factual issues are already apparent, which in and of itself warrants denial of the Motion pursuant to Rule 56(d)(1) to allow the parties time to develop the record. For this reason and the reasons set forth below, Opposer respectfully requests that the Board exercise its discretion pursuant to Rule 56(d)(1) and deny the Motion.

Significantly, Applicant’s Motion will not resolve this matter. Applicant has filed a counterclaim to cancel both of Opposer’s pleaded MANGO registrations on the grounds of abandonment, but has not moved for summary judgment on these claims. Regardless of the outcome of Applicant’s Motion, there is no set of circumstances in which Opposer would voluntarily surrender both of its registrations. LaBarge Decl. ¶ 14. Thus, unless Applicant intends to withdraw, with prejudice, its counterclaims should it prevail—which is not at all apparent from Footnote 1 in Applicant’s brief—its summary judgment motion will do nothing to advance its counterclaims and will only delay these proceedings.

Based on the facts currently available to Opposer, Opposer will also be seeking leave to amend its pleadings to assert that Applicant lacked a bona fide intent to use Applicant's Mark in commerce in connection with DVDs. Opposer has sufficient evidentiary support to assert this claim now based on extrinsic facts. LaBarge Decl. ¶¶ 15-20. Ordinarily, however, Opposer prefers to develop the record on claims such as this that depend partly on an applicant's intent and other information within an applicant's sole possession. *Id.* ¶ 20. Opposer had served discovery requests seeking to assess the viability of this claim shortly before Applicant filed the Motion. *Id.* ¶ 21. Even if the Board permits Rule 56(d)(2) discovery, such discovery would not fully elicit all of the facts relevant to assessing the viability of Opposer's new claim given the limited scope of such discovery. As a result, Opposer would be forced to assert a claim to preserve its rights, instead of waiting for Applicant's responses to outstanding discovery to assess whether it makes sense for Opposer to assert this claim in the first instance. This approach will result in litigation of these issues seriatim which, again, is not an efficient use of the Board's or the parties' time and resources.

Finally, the circumstances surrounding Applicant's filing and service of its Motion raise questions about Applicant's motives in filing the Motion. Applicant's demand for Opposer to withdraw the opposition with prejudice, and threatening to file a motion for summary judgment within 48 hours unless Opposer acceded to this demand, smacks of heavy-handed bad faith settlement negotiations and tactics. More troubling, however, is the fact that Opposer received the service copy of Applicant's Motion on December 8, 2011—one day before Opposer's response was due and over a month after Applicant filed the Motion. LaBarge Decl. ¶ 12. The envelope enclosing the service copy bears a postmark of December 5, 2011. *Id.* ¶ 12, Ex. D. Had the Board not quickly suspended this proceeding and placed Opposer on notice of

Applicant's Motion, Opposer may very well have been presented with a single day's notice in which to draft and file its response. In the absence of a credible and reasonable explanation for delayed service, the Board should deny Applicant's Motion outright and order Applicant not to re-file for summary judgment until after the close of the Discovery Period.

II. In the Alternative, Opposer Requires Discovery Of Facts Essential To Oppose Applicant's Motion.

Opposer cannot effectively oppose Applicant's Motion without Applicant's responses to Opposer's previous and timely-served discovery requests, which Opposer expects will elicit facts essential to support Opposer's opposition. See LaBarge Decl. ¶¶ 13-40, Exs. A, B, and C. "The Supreme Court has made clear that summary judgment is inappropriate unless a tribunal permits the parties adequate time for discovery." *Dunkin' Donuts of Am., Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917, 919 (Fed. Cir. 1988) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986)); *Orion Group, Inc. v. Orion Ins. Co., P.L.C.*, 12 U.S.P.Q. 2d 1923, 1924 (T.T.A.B. 1989) ("[I]t is well settled that the granting of a motion for summary judgment is inappropriate where the responding party has been denied discovery needed to enable it to respond to the motion.").

Indeed, the mandate of Rule 56(d)(2) is to prevent summary judgment in cases where, as here, the nonmoving party demonstrates a "sufficient basis" for its need to conduct discovery. *Opryland USA*, 970 F.2d at 852 ("Since [movant] has shown a sufficient basis for its need of additional discovery, it can not be deprived of additional discovery needed to place at issue material factual questions in opposition to the motion. That is the safeguard to which Rule 56[(d)] is directed."). The Board liberally construes Rule 56(d)(2) requests to guard against parties being "railroaded" by premature motions for summary judgment. See *Celotex Corp.*, 477 U.S. at 326. The accompanying declaration of Brent S. LaBarge conclusively demonstrates the

need for discovery on the below topics, and sets forth in detail the types of documents Opposer expects to find and its bases for such beliefs. *See Opreland USA*, 970 F.2d at 852 (Rule 56(d) discovery appropriate where “affidavit states more than a mere speculative hope of finding evidence that might tend to support a claim.”).

Rule 56(d) discovery is particularly appropriate in this case given the stage of the proceedings, Opposer’s diligence in seeking discovery, and the fact that the information sought by Opposer is exclusively within Applicant’s control. First, this opposition is still within the early stages of the discovery period, and neither party has had the benefit of receiving discovery responses from the other. Second, Opposer served discovery requests less than 48 hours after settlement discussions officially broke down, and roughly two weeks after the end of a moratorium on discovery agreed upon by the parties. *See, e.g., Ayala-Gerena v. Bristol-Myers Squibb Co.*, 95 F.3d 86, 92 (1st Cir. 1996) (“Rule 56[(d)] is designed to minister to the vigilant, not to those who slumber upon perceptible rights.”). Finally, as discussed below and in the accompanying affidavit, the information sought herein is almost exclusively within the control of Applicant. Rule 56(d) discovery is particularly appropriate in such circumstances. *See Orion Group*, 12 U.S.P.Q.2d at 1924-25.

In view of the foregoing, *at a minimum*, Opposer respectfully requests permission to pursue reasonable discovery related to the following pertinent *Du Pont* factors:

- A. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression (*Du Pont* Factor 1);
- B. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use (*Du Pont* Factor 2);

- C. The nature and extent of any actual confusion as well as the length of time during and conditions under which³ there has been concurrent use without evidence of actual confusion (*Du Pont* Factors 7-8); and
- D. Other established facts probative of the effect of use (*Du Pont* Factor 13), including: Applicant's intent and prior inconsistent statements made by Applicant in its dealings with third parties.

Regarding the *Du Pont* factors not relied upon by Applicant (i.e., B and D above), Opposer notes that the *Du Pont* factors are not considered in a vacuum; rather, the findings relative to certain factors inform and impact the findings with respect to others. For example, a strong mark will be accorded a broader scope of protection, requiring a lesser showing of similarities in sight, sound and meaning than a weak mark. *See, e.g., Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372-73 (Fed. Cir. 2005); *cf. also Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992) (when marks appear on virtually identical goods or services degree of similarity necessary to support a conclusion of likely confusion declines). Accordingly, discovery should not be restricted to the factors addressed in Applicant's brief.

a. The Similarity or Dissimilarity of the Marks

Opposer respectfully requests the opportunity to conduct discovery regarding the appearance, sound, connotation, and commercial impression of Applicant's Mark to gather information essential to Opposer's opposition to Applicant's Motion. *See* LaBarge Decl. ¶¶ 23-29. Applicant devotes the majority of its brief to this single factor, relying almost exclusively on a comparison of the parties' respective marks in the abstract. Applicant fails to include any

³ Given the nature of this factor, many of the other *Du Pont* factors are necessarily subsumed therein, and Opposer is also seeking discovery with respect to these other factors.

discussion of how Applicant has actually used, how consumers perceive, and how Applicant intends consumers to perceive, Applicant's Mark. Opposer believes that the foregoing information is far more relevant than the dictionary definitions and syllable counts relied on by Applicant, and seeks to discover this information from Applicant to support its arguments.

Applicant's repeated emphasis of the fact that its mark contains the highly descriptive wording "tropical cafe" illustrates the importance of discovery to Opposer in developing its counterarguments. Without waiving Opposer's right to argue that this is a distinction without a legal difference, the persuasiveness of Applicant's argument turns in part on whether consumers can visually perceive the wording "tropical cafe" and, if so, whether these same consumers would ascribe commercial significance to this wording.

In this regard, Opposer notes that Applicant is not working from a blank slate. Rather, Applicant "extensively" uses its mark in connection with a "variety" of goods and services, and has done so for over 20 years. *See* Appl.'s Br. at 15 and accompanying Declaration of David Wallack (Wallack Decl.) ¶¶ 2-3. According to USPTO records, Applicant has even used its mark in connection with CDs. *See* LaBarge Decl. ¶ 32.

As a result of these decades of use, Opposer believes that Applicant has a wealth of information exclusively within its control that would demonstrate how Applicant actually uses and promotes its mark and, in turn, how consumers perceive this mark. Notwithstanding Applicant's focus on dictionary definitions and syllable counts, it is well established that trademark proprietors cannot compel consumers to perceive or pronounce their marks in a certain way. *See, e.g., In re Great Lakes Canning, Inc.*, 227 U.S.P.Q. 483, 485 (T.T.A.B. 1985) ("[T]here is no such thing as a 'correct' pronunciation of a trademark."); *In re mnmco llc*, Ser.

No. 78622540, at 6 (T.T.A.B. Dec. 14, 2007)⁴ (“Trademark proprietors have little influence on how their customers pronounce marks.”).

Nor can trademark proprietors compel consumers to accord equal significance to all parts of a mark. Although Applicant correctly notes that the likelihood of confusion analysis must be based on a comparison of the parties’ marks in their entireties, it is equally well-established that “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties.” *In re Globe Union Indus. Corp.*, Ser. No. 76597662, at 4 (T.T.A.B. Aug. 22, 2006)⁵ (citing *In re Nat’l Data Corp.*, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985)). This is particularly true, where, as here, wording such as “tropical cafe” is generic or descriptive and thus has no source-identifying significance. *See Globe Union* at 4 (denying registration of TIBURON in light of prior registration for TIBERON TILEWORKS in part because “the word TILEWORKS . . . has virtually no source-indicating significance, and is entitled to less weight in the likelihood of confusion analysis”). Opposer believes that discovery will corroborate the fact that consumers do not attribute any significance to the wording “tropical cafe,” and thus that this wording should be accorded less significance in the Board’s analysis.

Applicant’s website alone reveals that Applicant is in possession of highly probative information that bears on the significance of the wording “tropical cafe.” By way of example:

- (1) Applicant does not always use the wording “tropical cafe”;
- (2) Applicant frequently uses the wording “tropical cafe” in a manner that renders this wording visually imperceptible at a distance or even at close range; and

⁴ Accessible at <http://des.uspto.gov/Foia/ReterivePdf?flNm=78622540-12-14-2007&system=TTABIS>.

⁵ Accessible at <http://des.uspto.gov/Foia/ReterivePdf?flNm=76597662-08-22-2006&system=TTABIS>.

(3) Both Applicant and consumers refer to Applicant and its goods and services simply as “Mango’s.”

See LaBarge Decl. ¶¶ 25-27, Ex. E. Of course, Applicant’s online presence reflects only a small subset of the relevant information sought by Opposer. The information available on Applicant’s websites does not obviate the need for Opposer’s discovery requests that seek documents and specimens reflecting past, present, and planned uses of Applicant’s Mark on its goods, services, and advertising and promotional materials.

Opposer also seeks discovery regarding the considerations that went into Applicant’s selection and adoption of its mark. *See* LaBarge Decl. ¶ 29. Opposer expects that at least some of these materials will reveal the connotation and commercial impression that Applicant *intended* to convey to consumers. These materials are more probative and relevant than the dictionary definitions relied on by Applicant, and will be essential to supporting Opposer’s counterarguments.

b. The Nature of the Goods Described in the Contested Application

The nature of the DVDs covered by the Contested Application imposes significant physical and practical constraints on how Applicant can display its mark, increasing the significance of discovery related to specimens, advertisements, and other promotional materials that reflect actual or planned uses of Applicant’s Mark. The goods are obviously small in size, and consumers typically expect other informational content to accompany DVDs as well. These demands further reduce the space available for Applicant to display its mark. By way of comparison, the diameter of Opposer’s MANGO & Design mark on its CDs is less than three-quarters of an inch. *See* LaBarge Decl. ¶¶ 31-32, Ex. F.

In view of the foregoing, Opposer seeks discovery relating to Applicant's use or planned use of its mark on DVDs and CDs. With respect to the latter goods, Applicant allegedly sold CDs in the 1990s, and Opposer expects to discover representative examples of such CDs, or learn the location of same. LaBarge Decl. ¶ 32. Similarly, Opposer also seeks to discover a representative sample of each unique representation of Applicant's Mark on each type of good or service rendered by Applicant. Applicant already sells goods that might be expected to approximate the size constraints of a DVD (e.g., key chains, cigar cutters, lighters, sandals, etc.). With respect to Applicant's use of its mark on larger goods (e.g., t-shirts, shorts, bathing suits, calendars, etc.), these goods might still contain smaller representations of Applicant's Mark on hangtags, labels, or even on the face of the goods themselves. In any event, even larger representations of Applicant's Mark are relevant and essential to the counterarguments that Opposer plans to assert. *See id.*

a. Actual Confusion

Opposer requires discovery from Applicant to determine the probative value, *if any*, of the supposed absence of consumer confusion between the parties' marks. *See* LaBarge Decl. ¶¶ 36-38. Indeed, the two *Du Pont* factors (7 and 8) relating to actual confusion are the only other factors discussed in Applicant's brief, underscoring the need for discovery on these factors. Such discovery is necessary for Opposer to assess: (1) the probative value and relevance of the Declaration of David Wallack; and (2) the conditions under which the parties have concurrently used their marks without evidence of actual confusion.

First, it is not at all apparent to Opposer why the observations of Applicant's CEO are dispositive of—or even relevant to—the issue of the supposed absence of consumer confusion between the parties' goods and services. Accordingly, Opposer seeks discovery to assess the

relevancy of this declaration. *See* LaBarge Decl. ¶ 36. Opposer also expects that the deposition of Mr. Wallack (or other employees) may be necessary to elicit these facts. If, however, Applicant's discovery responses reveal that there has been no meaningful opportunity for consumer confusion, Mr. Wallack's declaration may very well be irrelevant, and Opposer may not need to depose Mr. Wallack in connection with Opposer's response to the Motion. Opposer will make that determination after it has had an opportunity to review Applicant's responses to Opposer's discovery requests.

Second, Opposer requires discovery with respect to the conditions under which there has been concurrent use of the parties' marks without evidence of actual confusion. Despite Applicant's 20-year existence, the alleged absence of consumer confusion during this same time frame only becomes relevant if there have been meaningful opportunities for such confusion to occur. Opposer thus needs discovery to assess whether such opportunities have existed (as well as the duration of time during which such opportunities arose). To this end, Opposer seeks discovery with respect to (a) the identification of all of the products and services sold in connection with Applicant's Mark; (b) the time period, geographic location, and volume of sales associated with the goods and services marketed under Applicant's Mark; (c) advertising activities in connection with the goods and services rendered under Applicant's Mark, including advertising expenditures, advertising volume, the media used for advertising, and related documentation showing actual advertisements; (d) the channels of trade for Applicant's goods and services; (e) the classes of consumers to whom Applicant's goods and services have been sold; and (f) the circumstances under which persons purchase Applicant's goods and services. *See* LaBarge Decl. ¶ 37.

b. Other Probative Factors:

i. Applicant's Intent

Opposer seeks discovery relating to Applicant's intentions behind its decision to expand the use of its mark to cover music CDs and DVDs. *See* LaBarge Decl. ¶ 33-35. The question of Applicant's intent is subsumed within the thirteenth *Du Pont* factor, which permits the Board to weigh "[a]ny other established fact probative of the effect of use." *Du Pont*, 476 F.2d at 1361. An applicant's bad faith is an appropriate consideration in the likelihood of confusion analysis. *See Estrada v. Telefonos de Mexico, S.A.B. de C.V.*, No. 10-1558, slip op. 12 (Fed. Cir. Nov. 20, 2011). In certain circumstances an Applicant's bad faith may very well tip the balance in favor of a finding of likelihood of confusion. *Id.* (paraphrasing Board's decision below).

Applicant was first apprised of Opposer's MANGO Marks at least as early as April 4, 2001, when one of Opposer's pleaded MANGO Marks was cited by an Examining Attorney against Applicant's CD Application. *See* LaBarge Decl. ¶ 33, Ex. G. Yet, despite this knowledge, Applicant has apparently moved forward with plans to use its mark in association with music CDs and, now, music DVDs. Accordingly, Opposer seeks discovery to learn Applicant's intent in proceeding with its plans after learning of Opposer's MANGO Marks.

Equally important, the citation of Opposer's MANGO Marks during the prosecution of Applicant's CD Application potentially colors the veracity of the statements contained in the Wallack Declaration. If Mr. Wallack was aware of the citation of Opposer's MANGO Marks against the CD Application, this calls into question the veracity of his statements or, at the very least, his diligence in compiling the statements set forth therein. Similarly, Mr. Wallack might have been apprised of Opposer's rights during the trademark clearance process (if any)

undertaken by Applicant. *See* LaBarge Decl. ¶ 33. Opposer should be permitted to test the credibility of Mr. Wallack.

ii. Applicant's Interactions With Third Parties

Finally, Opposer seeks discovery relating to prior inconsistent positions adopted by Applicant with respect to third-party efforts to use or register MANGO-formative trademarks. *See* LaBarge Decl. ¶¶ 40-41. Before the TTAB alone, Applicant has either opposed the registration of, or sought to cancel, the WILD MANGO RESTAURANT & BAR, JOHNNY MANGO'S, and MANGO GRILLE AND LIMBO BAR word marks. *Id.* ¶ 40. Applicant's prior position in these proceedings is difficult to reconcile with its position taken herein, namely, that Applicant's Mark does not conflict with Opposer's MANGO Marks when used in connection with legally identical goods. These prior inconsistent statements constitute admissible, probative evidence and are "illuminative of shade and tone in the total picture." *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 929 (C.C.P.A. 1978). Inconsistent positions taken by Applicant in cease and desist letters or responses thereto are similarly relevant. *See generally* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32.109 (4th ed. 2011).

RELIEF SOUGHT

In view of the foregoing, Opposer respectfully requests that the Board dismiss Applicant's Motion. In the alternative, Opposer seeks an opportunity to conduct reasonable discovery related to the topics described in Section II herein. As set forth in the LaBarge Declaration, these topics are covered by the following previously-served discovery requests, as amended by Paragraph 28 of the LaBarge Declaration:

- **Interrogatory Nos.: 1-14, 17, 19, 21-26** (*see* LaBarge Decl. Ex. A)
- **Document Request Nos.: 1-34, 37, 39-42** (*see* LaBarge Decl. Ex. B)
- **Request for Admission Nos.: 1-45, 47-49, 54-59** (*see* LaBarge Decl. Ex. C)

Opposer further seeks an opportunity to conduct any follow up discovery necessitated by Applicant's responses to the foregoing discovery requests, including an opportunity to depose Mr. Wallack or other individuals employed by Applicant, if necessary. Opposer hereby requests 75 days in which to conduct this discovery and to respond to Applicant's Motion, consisting of: 30 days for Applicant to respond to Opposer's initial discovery requests; an additional 30 days for Opposer to serve and for Applicant to respond to any follow up discovery requests (including depositions); and 15 days for Opposer to review Applicant's discovery responses and to draft a response on the merits to Applicant's Motion.

Should the Board deny Opposer's Rule 56(d) Motion, Opposer hereby requests an additional 30 days from the date of the Board's disposition thereof in which to submit a response on the merits to Applicant's Motion.

Dated: December 9, 2011

Respectfully submitted,

UNIVERSAL INTERNATIONAL MUSIC B.V.

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CERTIFICATE OF SERVICE

I hereby certify that, on December 9, 2011, a true and complete copy of the foregoing Opposer's Motion Pursuant to Federal Rule 56(d) has been served on Applicant by electronically transmitting said copy (with the consent of Applicant) to:

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